

REMARKS

This is a full and timely response to the outstanding non-final Office Action mailed October 3, 2005. Reconsideration and allowance of the application and pending claims are respectfully requested.

I. Claim Rejections - 35 U.S.C. § 102(e)

Claims 1, 3-10, 14-17, 20 and 21 have been rejected under 35 U.S.C. § 102(e) as being anticipated by Yacoub (U.S. 6,552, 813). Applicant respectfully traverses this rejection.

The PTO and the Federal Circuit provide that §102 anticipation requires each and every element of the claimed invention to be disclosed in a single prior art reference. (*In re Spada*, 911 F.2d 705, 15 USPQ2d 1655 (Fed. Cir. 1990).) Therefore, the absence from a cited §102 reference of any claimed element negates the anticipation. (*Kloster Speedsteel AB, et al v. Crucible, Inc., et al*, 793 F.2d 1565, 230 USPQ 81 (Fed. Cir. 1986)). Furthermore, “[a]nticipation requires that all of the elements and limitations of the claims are found within a single prior art reference.” (*Scripps Clinic and Research Found. v Genetech. Inc.*, 927 F.2d 1565, 1576, 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991). Moreover, the PTO and the Federal Circuit provide that §102 anticipation requires that there must be no difference between the claimed invention and the reference disclosure. (*Scripps Clinic and Research Found. v. Genetech, Inc.*, id.).

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In the present case, not every element of the claimed invention is disclosed in the Yacoub reference. Applicant discusses the Yacoub reference and Applicant's claims in the following.

Applicant's claim 1 provides as follows (emphasis added):

1. A method comprising:
receiving a print job having an associated print destination;
determining a first location associated with a source of the print job;
determining a second location associated with the print destination;
determining a printing policy associated with the print job; and
communicating the print job to the print destination if the print job satisfies the printing policy.

The Office asserts that Yacoub, at col. 4, lines 5-16, discloses receiving a print job having an associated print destination. However, the plain language of this cited passage disproves the assertion:

In sharp contrast to the methodology shown in FIG. 1, the user is relieved of many, if not all interaction with the printing process once the job is sent. At step 200, *the user sends a print job to a printer which has already been chosen by a default setting* or in the absence of a default, a "virtual" printer, according to the present invention. At step 200, the user has selected the parameters of the job such as the quality of the print job and the speed and whether the image should be in black and white or in color. Though speed and quality are inherently linked, with a higher quality leading to lower speed and a lower quality leading to a higher speed, the preferences are treated as separate.

(Yacoub, column 4, lines 5-16 (emphasis added)).

In Applicant's claim 1, a print job is received that has an associated print destination. Claim 1 further recites, "communicating the print job to the print destination if" Thus, in claim 1, the received print job includes the print destination to which the print job may later be sent. By contrast, the print job received in Yacoub does not include the print destination because the received print job is already at the print

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destination. In Yacoub, the user sends the print job to a printer that has already been chosen by a *default setting*. Yacoub does not teach that the print job arrives at the printer based on a print destination in the print job itself. Rather, Yacoub teaches that print job arrives at the printer based on a *default setting*. Yacoub says nothing about the print job itself having the print destination.

Accordingly, for at least this reason, Yacoub does not anticipate claim 1 or any of its dependents. Thus, the rejection of claims 1 and 3-9 should be removed.

The Office further asserts that Yacoub, at col. 4, lines 28-52, discloses determining a second location associated with the print destination. Yacoub states the following at col. 4, lines 28-52 (emphasis added):

For the preferences shown as part of steps 220, 230, 233 and 236, the networked printer according to one embodiment of the present invention operates as follows. When the print job is being sent, the virtual printer, which is an extension of the operating system, or a server, checks the user's preferences (step 210). If speed is a preference of the user (checked at step 220), then *the server or virtual printer will find out which printer out of all available printers is the fastest* (step 225). Availability may be defined as all non-busy printers or as all printers that are networked regardless of their busy or free status. If speed is not a preference of the user (checked at step 220), then the server or virtual printer will, in this model, automatically default to knowing that high quality is a preference of the user (checked at step 230). Once quality of print image is determined to be a preference of the user, then the next question is whether or not the print image should be in black-and-white or color. If the print image is to be in black-and-white (checked at step 233) then, according to step 240, *the server or virtual printer will find out which printer out of all available printers is the highest quality printer that prints in black and white*. However, if the user prefers a color image that is of high quality (checked at step 236, but defaults at yes) then, at step 240, *the server or software will find out which printer out of all available printers is the highest quality printer that can print in color*.

As the Office points out, Yacoub also states the following at col. 2, lines 8-15 (emphasis added):

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A virtual printer, as part of a client generating a print job, receives preferences from a user regarding the print job such as image quality and/or speed. The *virtual printer automatically determines which printer of the printers on the network comply with the print job preferences*. The *virtual printer then selects an appropriate printer* which complies with the preferences and is located physically near the user/client.

Applicant's claim 1 recites, "receiving a print job having an associated print destination". Claim 1 further recites, "a first location associated with a source of the print job" and "a second location associated with *the print destination*" (emphasis added). Claim 1 also recites, "communicating the print job to *the print destination* if . . ." (emphasis added). Thus, in claim 1, the received print job has a single print destination with which it is associated, as specifically identified by the definite article "the" in the phrase "*the print destination*". The print job of claim 1, therefore, can only be communicated to *the* singular print destination identified by the print job, and none other. Claim 1 does not allow for alternative print destinations or for the selection of different printers as is taught by Yacoub.

As noted above, Yacoub teaches that, "the server or virtual printer will find out *which printer out of all available printers* is the fastest", "the server or virtual printer will find out *which printer out of all available printers* is the highest quality printer that prints in black and white", and "the server or software will find out *which printer out of all available printers* is the highest quality printer that can print in color" (col. 4, lines 28-52 (emphasis added)). Yacoub also teaches, "*printers* on the network [that] comply with the print job preferences", and, "[t]he virtual printer . . . *selects an appropriate printer* which complies with the preferences . . ." (col. 2, lines 8-15 (emphasis added)). Clearly,

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there are a plurality of printers or print destinations identified by the print job preferences in Yacoub, and the virtual printer has a choice in selecting from the plurality of printers complying with those preferences. There is no such choice or selection permitted in Applicant's claim 1.

Accordingly, for these additional reasons, Yacoub does not anticipate claim 1 or any of its dependents. Thus, the rejection of claims 1 and 3-9 should be removed.

The Office further asserts that Yacoub, at the abstract and at col. 4, lines 5-52, discloses communicating the print job to the print destination if the print job satisfies the printing policy. Yacoub states the following at the abstract (emphasis added):

A virtual printer for print jobs printed on networked printers. First, the virtual printer checks a user's preferences regarding a print job the user wishes to send such as speed and image quality. Next, *the virtual printer determines, using a server, database or other query, the most appropriate printer complying with the print job preferences*, and located physically near the user and sends the print job to that printer. If the printer returns an error signal, *the virtual printer will determine a different printer which closely complies with the print job preferences and re-send the print job*. If a busy signal is returned, the user will be given the choice of waiting or having the virtual printer automatically determine the next available appropriate printer. When the print job is complete, the user will be notified of the physical location of the printer where the print job was processed.

Yacoub basically teaches a virtual printer that determines a most appropriate printer (of a plurality of available and complying printers) that complies with preferences of a print job, such as speed and image quality. The print job in Yacoub does not provide a print destination.

As noted above, Applicant's claim 1 discusses a received print job that has an associated print destination. Claim 1 recites, "a first location associated with a source of the print job" and "a second location associated with *the* print destination" (emphasis

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added). Claim 1 also recites, “communicating the print job to *the* print destination if . . .” (emphasis added). Thus, in claim 1, the received print job has a single print destination with which it is associated. The print job of claim 1 can only be communicated to *the* print destination identified by the print job, and none other. Claim 1 does not allow for alternative print destinations or for a determination of a “most appropriate printer complying with the print job preferences” as is taught in Yacoub.

Accordingly, for these additional reasons, Yacoub does not anticipate claim 1 or any of its dependents. Thus, the rejection of claims 1 and 3-9 should be removed.

Given that independent claims 10, 17 and 20 recite limitations similar to those in claim 1 discussed above, these claims and their dependents are also not anticipated by the Yacoub reference. Accordingly, the 102(e) rejection of claims 10, 14-17, 20 and 21 should also be removed.

II. Claim Rejections - 35 U.S.C. § 103(a)

Claims 2, 11, 12 and 18 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Yacoub in view of Nickerson (U.S. 6,078,406). Applicant respectfully traverses this rejection.

As has been acknowledged by the Court of Appeals for the Federal Circuit, the U.S. Patent and Trademark Office (“USPTO”) has the burden under section 103 to establish a *prima facie* case of obviousness by showing some objective teaching in the prior art or generally available knowledge of one of ordinary skill in the art that would lead that individual to the claimed invention. *See In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596, 1598

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(Fed. Cir. 1988). The Manual of Patent Examining Procedure (MPEP) section 2143 discusses the requirements of a *prima facie* case for obviousness. That section provides as follows:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teaching. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and reasonable expectation of success must be found in the prior art, and not based on applicant's disclosure.

In the present case, the prior art at least does not teach or suggest all of the claim limitations.

Claims 2, 11, 12 and 18 depend, respectively, from claims 1, 10 and 17, and therefore include the elements of their respective base claims. Regarding claims 2, 11, 12 and 18, the Office cites Nickerson only for its purported teaching of deleting the print job if the print job does not satisfy the printing policy, and not for any teaching or suggestion of the elements of claims 1, 10 and 17 discussed above. Furthermore, Applicant cannot find any such teaching or suggestion in Nickerson regarding such elements. Accordingly, Nickerson does not remedy the deficiencies of Yacoub noted above, and Applicant's claims 2, 11, 12 and 18 are allowable over the combination of these two references.

For at least these reasons, the 103(a) rejection of claims 2, 11, 12 and 18 should be removed.

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II. Claims Not Addressed

The Office did not address claims 22-29 in the present Office Action. Applicant notes, however, that such claims recite elements similar to those discussed above with regard to claims 1, 10, 17 and 20. Thus claims 22-29 are likewise allowable over the cited references for reasons similar to those pointed out above regarding the rejections of claims 1, 10, 17, 20 and their dependents.

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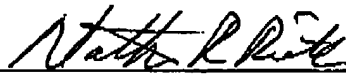
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CONCLUSION

Applicant respectfully submits that Applicant's pending claims are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (208) 396-5287.

Respectfully submitted,



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